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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,262	11/28/2001	Edward Anthony Bezek	CFLAY.00075	9131
22858	7590	01/05/2004	EXAMINER	
CARSTENS YEE & CAHOON, LLP P O BOX 802334 DALLAS, TX 75380			BECKER, DREW E	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,262

Applicant(s)

BEZEK ET AL.

Examiner

Drew E Becker

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on November 3, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Pat. No. 6,596,328 and Pat. No. 6,472,007 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 8-11, 14, and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller [Pat. No. 6,474,494].

Miller teaches a portable container comprising a cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #18), a removable cap over a first end of the receptacle which acts as a bowl (Figure 1, #14), a removable seal (Figure 1, #12), the cap containing promotional products such as chips and dip (column 4, line 44), the

receptacle containing a beverage (column 4, line 18), the receptacle having a hand grip (Figure 1), and a collar (Figure 1, #14BB).

4. Claims 1-2, 8-10, 13-15, 20-22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al [Pat. No. 6,068,865].

Lee et al teach a portable container comprising a cylindrical receptacle for holding a first food product (Figure 1, #30), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #20), a removable seal (Figure 1, #32), the cap containing promotional products such as chocolate (Figure 2, #24), the receptacle containing yoghurt (Figure 2, #34), the receptacle having a shape that provided a hand grip (Figure 1, #30), the cap having a collar or rim (Figure 1, #20), and the cap being transparent (column 6, line 30).

5. Claims 1-2, 8-12, 14-15, and 20 –24 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Rose [Pat. No. 2,076,132].

Le Rose teaches a portable container comprising a generally cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #7), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #15), a removable seal (Figure 2, #13), the cap containing promotional products such as ice cream (column 2, line 16), the receptacle containing soda (column 1, line 7), the receptacle having a shape that provided a hand grip (Figure 1, #9), the cap having a collar (Figure 1, #19), and the cap having a lip which engaged a groove in the receptacle (column 2, line 25).

6. Claims 1, 3-4, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nava et al [Pat. No. 6,070,752].

Nava et al teach a portable container comprising a generally cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #8), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #10), the cap containing promotional products such as CD's (Figure 2, #16), the receptacle containing soda (Figure 1, #9), the receptacle having a shape that provided a hand grip (Figure 1, #8), and the cap having a collar or rim (Figure 1, #23).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nava et al as applied above, in view of Kirshenbaum et al [Pat. No. 4,051,265].

Nava et al teaches the above mentioned components. Nava et al do not teach an outer layer which carries graphics and provides an oxygen barrier. Kirshenbaum et al teach a container and cap with an outer layer which provided an oxygen barrier (Figure 1, #14; abstract), as well as the use of graphics (column 5, lines 50-62). It would have been obvious to one of ordinary skill in the art to incorporate the outer layer of Kirshenbaum et al into the invention of Nava et al since both are directed to beverage containers,

since Nava et al already included a sealed container (Figure 1, #8 & 10), and since the outer layer of Kirshenbaum et al provided an effective oxygen barrier and thus better preserved the beverage (abstract). It would have been obvious to one of ordinary skill in the art to include graphics on the outer layer of Kirshenbaum et al since Kirshenbaum et al already included graphics on the container itself (column 5, lines 50-62), since outer layers commonly included graphics, and since graphics on the outer layer would have made the product more distinctive looking and set it apart from its competitors.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Rose as applied above, in view of Nava et al.

Le Rose teaches the above mentioned components. Le Rose does not teach the promotional item being a prize, toy, coupon, ball, contest item, or collectible. Nava et al teach a portable container comprising a generally cylindrical receptacle for holding a first product (Figure 1, #8), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #10), and the cap containing a contest item such as CD's (Figure 2, #16). It would have been obvious to one of ordinary skill in the art to incorporate the contest item of Nava et al into the invention of Le Rose since both are directed to beverage containers, since Le Rose already included a cap which contained a promotional item (Figure 1, #15), and since the contest item of Nava et al would have improved the consumer's desire to purchase the product due to their chance of winning a prize.

10. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Rose, in view of Nava et al, as applied above, and further in view of Kirshenbaum et al [Pat. No. 4,051,265].

Le Rose and Nava et al teach the above mentioned components. Le Rose and Nava et al do not teach an outer layer which carries graphics and provides an oxygen barrier. Kirshenbaum et al teach a container and cap with an outer layer which provided an oxygen barrier (Figure 1, #14; abstract), as well as the use of graphics (column 5, lines 50-62). It would have been obvious to one of ordinary skill in the art to incorporate the outer layer of Kirshenbaum et al into the invention of Le Rose, in view of Nava et al, since both are directed to beverage containers, since Nava et al already included a sealed container (Figure 1, #8 & 10), and since the outer layer of Kirshenbaum et al provided an effective oxygen barrier and thus better preserved the beverage (abstract). It would have been obvious to one of ordinary skill in the art to include graphics on the outer layer of Kirshenbaum et al since Kirshenbaum et al already included graphics on the container itself (column 5, lines 50-62), since outer layers commonly included graphics, and since graphics on the outer layer would have made the product more distinctive looking and set it apart from its competitors.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Rose as applied above, in view of Howes [Pat. No. 5,076,433].

Le Rose teaches the above mentioned components. Le Rose does not teach a promotional item attached to a second end of the receptacle. Howes teaches a container comprising a promotional item attached to a second end of the receptacle

(Figure 1, #21). It would have been obvious to one of ordinary skill in the art to incorporate the bottom attached promotional item of Howes into the invention of Le Rose since both are directed to beverage containers, since Le Rose already included an additional product attached to the first end (Figure 2, #16), since consumers greatly valued promotional items such as prizes, and since the bottom promotional item of Howes has the advantage of providing a prize, while being completely indistinguishable from a non-prize bearing container (column 2, lines 39-48).

Response to Arguments

12. Applicant's arguments filed November 3, 2003 have been fully considered but they are not persuasive.

Applicant argue that "promotional items" cannot be food. However, the portion of their disclosure which they rely upon simply states that the promotional item can be items "such as" a prize, a toy, a ball, a contest item, a collectible, a coupon, or non-food item (page 21). The above items were merely a few examples of possible promotional items and were not the only alternatives. In addition, there is no mention in the claims that the promotional item cannot be a food product. Furthermore, the sentence which was left out reads: "Although the containers illustrated in Figures 9 and 10 illustrate a chip and dip combination, the present invention is not limited to a chip and dip combination nor is it limited to food products".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., promotional items which cannot be food products) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that a beverage is not a food item. However, beverages were indeed a common type of food in liquid form.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a collar as described in the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a snap-on connection) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Nava et al does not teach a cap holding a promotional item. However, Nava et al explicitly teach a cap holding a promotional item (Figure 1, #10).

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Monday-Thursday 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

A handwritten signature in black ink, appearing to read "Drew Becker", with a long horizontal flourish extending to the right.

Drew E Becker
Primary Examiner
Art Unit 1761